

**REMARKS**

The Office Action in the above-identified application has been carefully considered and this amendment has been presented to place this application in condition for allowance.

Accordingly, reexamination and reconsideration of this application are respectfully requested.

Claims 1-3 and 6-8 are in the present application. It is submitted that these claims, as originally presented, were patentably distinct over the prior art cited by the Examiner, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. Changes to the claims, as presented herein, are not made for the purpose of patentability within the meaning of 35 U.S.C. sections 101, 102, 103 or 112. Rather, these changes are submitted simply for clarification and to round out the scope of protection to which Applicants are entitled.

As to the rejection based upon 35 U.S.C. § 112, the claims have been amended to address each of the concerns raised by the Examiner. No new matter has been added.

Claims 1-3 and 7 were rejected under 35 U.S.C. § 103(b) as being allegedly unpatentable by U.S. Patent No. 5,411,792 to Yukinobu et al. in view of U.S. Patent No. 6,265,051 to Jean.

The present invention is directed to a “transparent conductive film being made of a metal oxide having a specific resistance of  $3.0 \times 10^{-4}$  ohm-cm or less when the substrate is heated to a temperature of 150 degrees C or more, formed by sputtering, ion plating or electron beam deposition methods.” (Claim 1). Yukinobu does not, either alone or in combination with Jean, disclose, teach, suggest or enable the present invention.

The Examiner alleges that indium-tin oxide (“ITO”) would inherently have a specific resistance of  $3.0 \times 10^{-4}$  ohm-cm or lower when a substrate is heated to a temperature of 150 degrees C or higher, and that this position is based on the Applicant’s own disclosure (*Office Action*, at 4). However, the ITO film in Yukinobu comprises a binding resin and ultra-fine

particles of indium tin oxide dispersed therein formed by a printing method. In contrast, the present invention discloses that the transparent conductive film is formed by sputtering, ion plating or electron beam deposition methods.

It is respectfully submitted that the film in Yukinobu cannot meet the claimed resistance when the substrate is heated to a temperature of 150 degrees C or higher because the film composition and the forming method is different than the present invention. For example, unlike the present invention, Yukinobu relates to a film comprising a binding resin and ultra-fine particles of ITO dispersed therein formed by a printing method. Thus, the ITO in Yukinobu cannot inherently meet the claims of the present invention as the composition and the forming methods are different.

Further, Yukinobu teaches away from the claimed invention. Yukinobu teaches that the film formed by the sputtering method and the like, as claimed in the present invention, present problems associated with expensive equipment, productivity or high yield, thereby hardly permitting manufacturing of transparent conductive layers. (Yukinobu at col. 1, lines 13-22). To avoid these problematic deposition methods, Yukinobu relates to transparent conductive films formed by printing and setting conductive inks which contains ultra-fine particle size smaller than the wavelength of visible light (Yukinobu at col. 1, lines 23-28). Thus, Yukinobu teaches away from the claimed forming methods and a skilled artisan would not modify Yukinobu in any manner to meet the claims of the present invention.

Jean does not remedy these inherent deficiencies. Jean relates to edge connectors for printed circuit boards. Jean fails to disclose that transparent conductive film being made of a metal oxide having a specific resistance of  $3.0 \times 10^{-4}$  ohm-cm or less when the substrate is heated to a temperature of 150 degrees C or more, formed by sputtering, ion plating or electron beam

deposition methods. Thus, any combination of Yukinobu and Jean would not lead a skilled artisan to practice the instantly claimed invention.

Accordingly, Yukinobu does not, either alone or in combination with Jean, disclose, teach, suggest or enable the present invention. In fact, Yukinobu teaches away from the present invention.

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokinobu, and Jean in view of Sato et al. (U.S. Patent 5,155,005). Sato is relied upon solely to meet the present invention's color filter layer limitation. However, since dependent claim 6 inherits the limitations of independent claim 1, the rejection based on the additional reference to Sato should be withdrawn in view of the foregoing discussion.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Yokinobu and Jean in view of Oka et al. (U.S. Patent 5,747,152). Oka is relied upon solely to meet the present invention's hardened resin layer limitation. However, since dependent claim 8 inherits the limitations of independent claim 1, the rejection based on the additional reference to Oka should be withdrawn in view of the foregoing discussion.

In view of the foregoing amendment and remarks, it is respectfully submitted that the application as now presented is in condition for allowance. Early and favorable reconsideration of the application are respectfully requested.

No additional fees are deemed to be required for the filing of this amendment, but if such are, the Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

Accordingly, it is submitted that the invention as claimed is distinct from the art and a notice of allowance is earnestly solicited.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP

By:

A handwritten signature in black ink, appearing to read 'Ronald R. Santucci', written over a horizontal line.

Ronald R. Santucci

Reg. No. 28,988

(212) 588-0800